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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,261	01/21/2002	Mark D. Latunski	5898-000190	7054
27572	7590	03/09/2004	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,261

Applicant(s)

LATUNSKI ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 39-109 and 111 is/are allowed.
- 6) ☒ Claim(s) 1,3-7,13-15,17-19,21,23-27,31,34 and 110 is/are rejected.
- 7) ☒ Claim(s) 2,8-12,16,20,22,28-30,32,33 and 35-38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 12/10/03. It is noted that the double patenting rejections of record are rendered moot in light of applicants filing of proper terminal disclaimer on 12/10/03.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3-6, 15, 17-19, 21, 23-27, 31, 34, and 110 are rejected under 35 U.S.C. 102(b) as being anticipated by Krishnan et al. (U.S. 5,778,789).

The rejection is adequately set forth in paragraph 6 of the office action mailed 9/5/03 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. (U.S. 5,778,789) in view of JP 08108662.

The rejection is adequately set forth in paragraph 9 of the office action mailed 9/5/03 and is incorporated here by reference.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnan et al. (U.S. 5,778,789) in view of Britton, Jr. (U.S. 5,024,700).

The rejection is adequately set forth in paragraph 10 of the office action mailed 9/5/03 and is incorporated here by reference.

Response to Arguments

7. Applicants arguments filed 12/10/03 have been fully considered but they are not persuasive.

Specifically, applicants argue that Krishnan et al. is not a relevant reference against the present claims given that Krishnan et al. disclose ink wherein water is the continuous phase and the polymer is emulsified which is in direct contrast to the present claims which require continuous phase comprising polymer and emulsified phase comprising water.

However, it is the examiner's position that Krishnan et al. remains a relevant reference against the present claims for the following reasons.

Firstly, it is noted that the present claims are drawn to ink composition not method of making the ink. That is, regardless of how Krishnan et al. combines the ingredients to make the ink, the fact remains that the end result of Krishna et al. is ink comprising hydrogen bonding vinyl polymer and water which is identical to the ink presently claimed.

Krishnan et al. disclose ink comprising water and binder such as polyvinyl alcohol, polyvinyl pyrrolidone, polyacrylamide, or methacrylic resin. These polymers are hydrogen bonding vinyl polymers comprising hydrogen bonding groups including carboxylic acid, primary

amine, etc. In the present invention (see pages 33-34 of the present specification), the ink is prepared by mixing continuous phase comprising hydrogen bonding polymer and emulsified phase comprising water. Such mixture results in ink comprising hydrogen bonding vinyl polymer and water. Krishnan et al. also disclose ink comprising hydrogen bonding vinyl polymer and water. The present invention discloses single phase ink produced by combining continuous phase and emulsified phase wherein hydrogen bonding between the phases produces the single phase ink. Krishnan et al. disclose single phase ink (col.5m lines 41-42). Given that the end result is the same, i.e. both the present invention and Krishnan et al. utilize single phase ink, it is clear that Krishnan et al. meets the requirements of the present claims. Further, it is noted that given that Krishnan et al. disclose ink comprising hydrogen bonding vinyl polymers and water, it is clear that the hydrogen bonding vinyl polymers of Krishnan et al. would also form hydrogen bonds with water identical to that of the present invention.

Thus, regardless of how Krishnan et al. refers to the ingredients of the ink, i.e. referring to water as continuous phase as opposed to emulsified phase as presently claimed, or how the ingredients are combined to produce ink, given that the end result of Krishnan et al. is ink composition comprising same ingredients as presently claimed, Krishnan et al. remains a relevant reference against the present claims.

Applicants also argue that the ink of Krishnan et al. must be used with special, silicone coated plates that are not required in the present invention. However, the present claims are not drawn to process of using the ink. Given that it is the examiner's position that Krishnan et al. disclose ink as presently claimed, the ink of Krishnan et al. meets the limitations of the present claims regardless of the types of plates utilized with the ink.

In light of the above, Krishnan et al. remains a relevant reference against the present claims.

Allowable Subject Matter

8. It is noted that claims 39-109 and 111 remain allowable over the prior art for the reasons set forth in paragraph 11 of the office action mailed 9/5/03 while claims 9-12, 16, 20, 22, 28-30, 32-33, and 35-38 remain objected to for the reasons set forth in paragraph 12 of the office action mailed 9/5/03.

9. Claims 2 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2 and 8 would be would be allowable if re-written in independent form including all of the limitations of the base claim and any intervening claims for the following reasons.

Krishnan et al. (U.S. 5,778,789) disclose lithographic ink comprising water, 0-5% polymer such as polyvinyl alcohol, polyvinyl pyrrolidone, or polyacrylamide, 10-70% methacrylic resin or polystyrene sulfonic acid, 0-20% polymer obtained from (meth)acrylic ester, and 2% weak acid or base. However, there is no disclosure or suggestion that the lithographic ink comprises emulsified phase comprising liquid polyol or that the lithographic ink comprises non-aqueous phase as required in present claims 2 and 8, respectively.

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10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

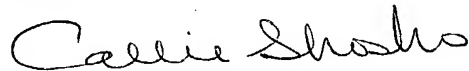
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
3/6/04